

Remarks

The status of the application is as follows. Claims 1-19 were presented for prosecution. By the present amendment, claim 1 has been amended. No new matter is believed added.

Claims 1-19 are rejected under 35 USC 103(a) over Clark et al., U.S. Patent 5,710,889 ("Clark") in view of Jai et al., U.S. Patent 5,991,402 ("Jai"). Applicant respectfully traverses this rejection for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In the present case, the cited combination of references fails to meet each of the three basic criteria required to establish a *prima facie* case of obviousness.

As stated previously in the Response filed September 17, 2003, and repeated herein, it is noted that the Office Action appears to be missing portions of the Examiner's arguments. In particular, on page 3, lines 1-3 of the above-referenced Office Action, the Examiner alleges that the "institutional server includes a system for separately serving a first database containing private and a second database containing (see., fig 1, abstract, col 3, lines 18-35, repository and archive facility)." It is not clear what the Examiner intended to present after the word "containing." Further, it should be noted that the Examiner has failed to address the claimed "service provider"; the rejection only

addresses the claimed “institutional server” (Office Action, page 3, lines 1-3) and the claimed “client” (Office Action page 3, lines 4-7). Thus, no prior art teaching is alleged for, *inter alia*, the claimed “service provider, wherein the service provider includes a system for receiving an encrypted version of the private data and an unencrypted version of the public data from the institutional server” (claim 1), the claimed step of “storing an encrypted copy of the private data and an unencrypted copy of the public data with an intermediary service provider,” (claim 10), the claimed step of “loading to a client the encrypted private data from the institution and the unencrypted copy of the public data from the service provider,” (claim 14), and the claimed “system for providing a copy of the second database of unencrypted data to an intermediary service provider” (claim 18). Clarification of the rejection is respectfully requested.

Applicant submits that Clark and Jai fail to teach these, as well as other numerous claim features of the present invention. For instance, with regard to claim 1, the Examiner appears to allege (see above) that Clark teaches an institutional server for separately serving a first database of private data and a second database of public data. However, no such distinction is made between private and public data in Clark. On the contrary, Clark only discloses the serving of “private” messages to customer facilities 12, wherein the messages are communicated from repository 11 to a customer facility(ies) 12 only in response to an approval by entitlement system 16. Claim 1 further recites “a service provider, wherein the service provider includes a system for receiving an encrypted version of the private data and an unencrypted version of the public data from the institutional server.” As stated above, Clark fails to disclose a service provider that receives encrypted private data and unencrypted public data from an institutional server.

Further, since Clark fails to disclose an institutional server for separately serving a first database of private data and a second database of public data, Clark cannot possibly disclose the display of a merged version of the private and public data. In the Office Action, the Examiner alleges that this feature is disclosed in FIGS. 15, 17, 20, 23, 24, 28, and in col. 6, lines 37-47, col. 14, lines 10-22, and col. 21, lines 16-25. However, the Examiner has made no attempt to distinguish between private and public data in any of these FIGS./sections of Clark.

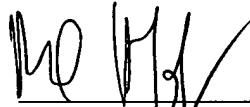
Attempting to modify Clark using Jai fails to remedy these numerous deficiencies. Jai teaches a system that resides on a computer operating system and essentially allows encrypted material to remain encrypted if it is to be delivered over a network, or be decrypted if it is required by an operating system component. Jai's system resides at a single critical data path in a computer operating system. Jai does not teach or suggest a system for processing **separate** databases of encrypted material and unencrypted material. Accordingly, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, nor is there a reasonable expectation of success.

Moreover, Jai specifically teaches away from the concept of an intermediate service provider that receives "an encrypted version of the private data and an unencrypted version of the public data." Jai explicitly states that the "apparatus utilized in this invention **does not create any intermediate storage** of decrypted material that is under the protection of this technology." (See column 3, lines 24-27.) Accordingly, a person skilled in the art would clearly not be motivated to combine the two references.

Furthermore, there is clearly no teaching in either reference that allows a customer to "remain anonymous to the intermediary service provider," as recited in claims 3, 10, 14, and 18. The Examiner's position that Jai discloses this in the abstract, Figure 1 and item 108 is clearly without merit, as Jai teaches away from an intermediary service provider; the abstract makes no mention of anonymity; and Figure 1 and item 108 do not show any mechanism for allowing a customer to remain anonymous.

Accordingly, Applicant respectfully submits that all claims are in condition for allowance. If the Examiner believes that anything further is necessary to place the application in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Michael F. Hoffman
Reg. No. 40,019

Dated: 2/25/04

Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, NY 12207
(518) 449-0044 - Telephone
(518) 449-0047 - Facsimile